REMARKS

Reconsideration and allowance are requested. Claims 29, 30, 34, 35 and 39-44 are under consideration and rejected by the Examiner. Claims 1 - 28 have been cancelled.

REJECTION OF CLAIMS 29 UNDER SECTION 102(E)

The Examiner rejects claim 29 under Section 102(e) in view of Suzuki et al. Applicants traverse the Examiner's new reasoning to reject claim 29. Applicants will explain the following below: (1) The Examiner inappropriately combines Suzuki et al. with the Exhibit D reference attached to Applicant's declaration, paper #26 (referred to herein as "N1277") in the Section 102(e) rejection; (2) At best, combining Suzuki et al. with N1277 to reject claim 29 should be accomplished in a Section 103 rejection; however, a fair analysis of Suzuki et al., N1277 and the previously submitted declarations of the inventors illustrate that under the Examiner's new reasoning for rejecting claim 29, the declarations of the inventors increase in relevance and based on the portions of Suzuki et al. and N1277, it is clear the material relied upon to reject claim 29 is Applicants' own work.

Combining Suzuki et al. with N1277 is Inappropriate for a Section 102(e) Rejection

The Examiner cites column 31, lines 42-46 asserting that the one-bit flag for scalability discloses assigning priorities to video object layers. Here, Suzuki et al. state:

> Further, a one-bit flag scalability (the portion shown by A3 in FIG. 35) specifies which of the lower and upper layers is the VOL. For example, if the VOL is the lower layer, the flag scalability may be set to 0; whereas, if the VOL is the upper layer, the flag scalability may be set to 1. Col. 31, lines 42-46.

Figure 35, feature A3, provides more information on the one-bit scalability flag. The Examiner concludes that "when there are only two VOLs, the flag carries priority information....[T]he base layer that is the lower layer has the high priority because in the decoding process merely data of an enhancement layer cannot be used to generate any meaningful image."

However, instead of drawing upon the use and purpose of the upper and lower layers as set forth in Suzuki et al. (picture size-based layering as explained in previous Remarks), the Examiner reaches to ISO/IEC JTCI/SC29/WG11 N1277 ("N1277").

Applicants traverse the use of Section 102(e) to reject claim 29 using a combination of Suzuki et al. and N1277. Use of more than one reference in a 102(e) rejection can only be used to (1) prove that the primary reference contains an enabled disclosure; (2) explain the meaning of a term used in the primary reference; and (3) show that a characteristic not disclosed in the reference is inherent. MPEP 2131.01. Applicants believe that the Examiner is attempting to use reason (2) when he states that "the cited passages [of Suzuki et al.] are related to ... N1277...." However, extrinsic evidence may be used to explain but not expand upon the meaning of terms and phrases used in the reference. The Examiner uses 6 pages of N1277 to expand the sparse disclosure of the one-bit flag for scalability into material that he asserts discloses assigning priorities to video object layers (col. 30, lines 62-63, col. 31, lines 42-46 cited by Examiner). In so doing, the Examiner completely changes the Suzuki et al. use and purpose of the picture size-based layering scheme to that taught in N1277. Applicants submit that at best, this should be a Section 103 rejection. The Applicants formally request that the Examiner withdraw the Section 102(e) rejection. If the Examiner maintains the two-reference rejection under Section 102(e), the Applicants request an articulation of why this is appropriate in view of the MPEP requirements.

Under the Examiner's New Rejection Reasoning, Suzuki et al. should be removed as a 102(e) Reference

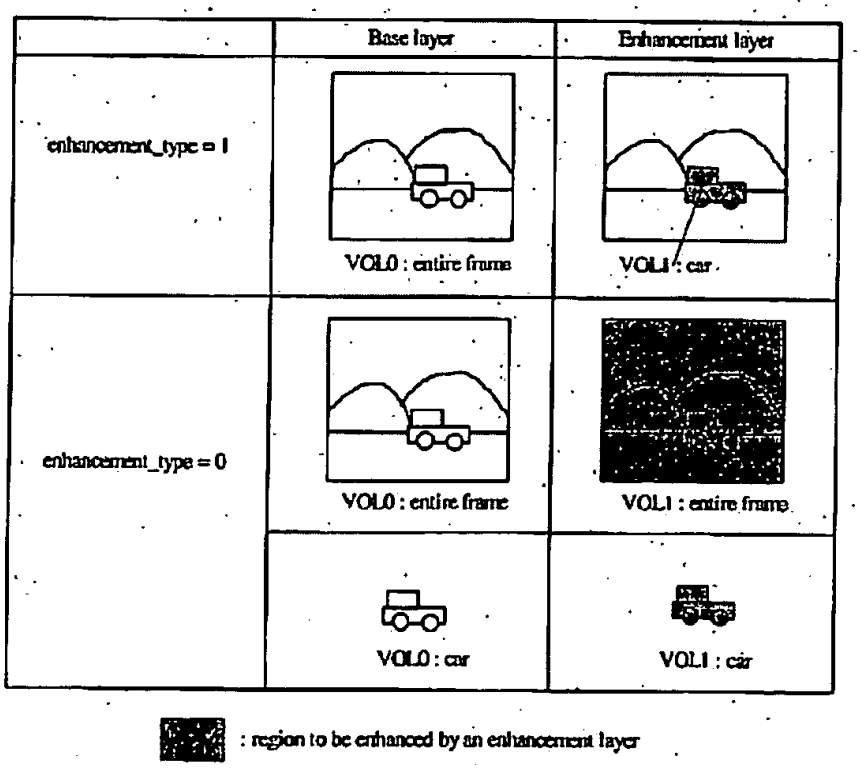
The Examiner has drawn upon pages 45-50 of N1277 to support his conclusion that the base layer, as the lower layer, has higher priority because in the decoding process, merely data of an enhancement layer cannot be used to generate any meaningful image. Applicants assume this material is drawn from page 49 of N1277, which concludes the section on temporal scalability (section 3.7.2). Page 49 of N1277 states:

There are two types of enhancements for scalability, described by the enhancement_type flag. We explain below the meaning of enhancement_type flag in more detail. As an example, Figure 3.7.4 shows an entire image containing several types of regions; for example a road, a car, and mountains. Both the base layer with enhancement_type being "0" and the base layer with enhancement_type being "1" are coded with lower picture quality which means that either the frame rate is lower or the spatial resolution is lower. At the enhancement layer of the scalability, enhancement_type flag distinguishes the following two cases:

- When this flag is "1", the enhancement layer increases the picture quality of a partial region of the base layer. For example, in Figure 3.7.4, VOL0 is an entire frame and VOL1 is the car in the frame. The temporal resolution or the spatial resolution of the car is enhanced.

- When this flag is "0", the enhancement layer increases the picture quality of the entire region of the base layer. For example, tin Figure 3.7.4, if VOL0 represents an entire frame, VOL1 is also the entire frame. Then the temporal or spatial resolution of entire frame is enhanced. If VOL0 represents the car, VOL1 is also the car which is enhanced in terms of temporal or spatial resolution.

Figure 3.7.4 from N1277 shows the following:



If the Examiner is correct in his interpretation of N1277 as disclosing a "priority" between a base layer over an enhancement layer because the enhancement layer increases the spatial or

temporal resolution of either the entire frame or an object within the frame, then the inventor declarations establish that this subject matter in N1277 is Applicants' own work. The Examiner in the Advisory Action dated 03/13/2003 stated in response to Applicants' declarations, that "the declarations do not state that the attached documents to the declarations disclosed the **whole** invention." (emphasis in original). This standard imposed by the Examiner is inappropriate and higher than the standard set forth in the MPEP.

The MPEP states that to overcome a Section 102(e) rejection by antedating the filing date of the prior art patent, the application can submit an affidavit or declaration establishing that the "relevant disclosure is applicant's own work." MPEP 2136.05. There is simply no requirement that the declaration set forth each and every element (the 'whole') invention to match each limitation to specific disclosure. Based on the Exhibits attached to the declarations, it is easy to establish that the subject matter that the Examiner relies upon to reject claim 29 is Applicants' own work.

For example, Exhibit A is a proposed scalability syntax submitted to the standards body by Applicants. This document was generated by Applicants (AT&T) and Sharp Corporation. Applicants, in their declarations at paragraph 5, explain that the submitted Exhibit A highlights the portions proposed by Applicants and those proposed by Sharp Corp. In terms of the steps recited in claim 29, each element is shown in Exhibit A. Although it is not necessary to step through each element of the invention of claim 29, Applicants will show that all of claim 29's limitations are shown in Exhibit A and that this same disclosure was adopted into N1277. Therefore, the disclosure relied upon in N1277 is Applicants own work and Suzuki et al. is thus antedated.

Exhibit A relates to a video coding method. The steps of identifying a video object from video data, coding time instances of the video object as a plurality of coded video object planes (VOPs), and assigning each of the VOPs to one of a plurality of video object layers (VOLs) for the video object based on the information content thereof, are all clearly disclosed on page 1. On this

first page, Applicants propose a hierarchy video objects (VO), video object layers (VOL) and video object planes (VOP). Applicants state "In scalable coding VOL0 would be the base layer and VOL1 the first enhancement layer and so forth."

The claim 29 limitation of assigning a priority to each VOL is clearly shown in Exhibit A on page 7 and in the Summary. This summarizes the proposed syntax by Applicants and concludes with the exact same figure shown above that was incorporated into N1277. Further, the text in Exhibit A, right before the "Summary" heading, is incorporated almost word-for-word into N1277. This is the same text quoted above. Therefore, if the Examiner maintains that N1277 teaches a priority between the base layer and enhancement layer, then the Applicants declarations clearly establish that the disclosure relevant to rejecting claim 29 is Applicants' own work.

Finally, the steps of transmitting each VOL by transmitting an identifier of the VOL's priority and transmitting VOPs of the VOL can easily be shown by the text above from N1277 and on page 7 of Exhibit A. The enhancement_type flag identifies the type of enhancement is associated with a VOL, and this flag is transmitted as well as the VOPs are transmitted.

In sum, each element of claim 29 is easily matched to Exhibit A, and all the supporting material was incorporated by the standards body into N1277. Therefore, this subject matter is Applicant's own work and the Section 102(e) reference is antedated.

If the Examiner maintains his position that the declarations and documents must state and demonstrate that the Applicants invented the whole invention prior to the filing date of Suzuki et al., Applicants request a citation to support this heightened requirement.

Applicants respectfully submit that claim 29 is patentable and in condition for allowance.

REJECTION OF CLAIMS 29 - 30 UNDER SECTION 103

The Examiner rejects claims 29 – 30 under Section 103 as being unpatentable over Suzuki et al. in view of ISO/IEC N1993. Applicants respectfully traverse this rejection and submit that these claims are patentable over the prior art of record.

In this rejection, the Examiner cites Fig. 32 of Suzuki et al. to match the first three limitations of claim 29. As set forth above, Applicants have shown that the subject matter relied upon in the Section 102(e) rejection is Applicants' own work, therefore Suzuki et al. is antedated as prior art. Regarding the use of FIG. 32 of Suzuki et al., this same figure is found as FIG. 1 of Exhibit A attached to Applicants' declarations. Therefore, this same figure is clearly "applicants own work" inasmuch as the evidence of record establishes that Applicants proposed this figure to the standards body. Thus, the previously submitted declarations and documentation remove Suzuki et al. as a reference.

Claim 30 depends from claim 29 and therefore, this claim inherits all the limitations of claim 29 discussed above. Therefore, claims 29 and 30 are patentable and in condition for allowance.

REJECTION OF CLAIMS 34, 39-41 and 43-44 UNDER SECTION 103

The Examiner rejects claims 34, 39 – 41 and 43-44 under Section 103 as being unpatentable over Suzuki et al. and Chang et al. The Examiner cites N1277 and FIG. 32 of Suzuki et al. to reject these claims as well. Applicants submit that for the same reasons set forth above, Suzuki et al. is antedated as prior art. Therefore, claims 34, 39-41 and 43-44 are patentable over the prior art of record and in condition for allowance.

REJECTION OF CLAIMS 34 - 35 and 39 - 44 UNDER SECTION 103

The rejection of claims 34, 35 and 39 – 44 under section 103 similarly cites Suzuki et al. in the same manner as set forth above, utilizing FIG. 32 and N1277. Therefore, since Suzuki et al. is antedated as a reference, Applicants submit that these claims are also patentable and in condition for allowance.

CONCLUSION

Having addressed the rejection of claims 29-30, 34-35 and 39-44, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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